

**REMARKS / ARGUMENTS**

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1, 2, 4-16, 18 and 19 were pending, and presently, Claims 1, 2, 4-16, 18 and 19 stand rejected.

**Rejections Under 35 U.S.C. § 102(b)**

In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(b), a primary tenet is that the reference must teach every element of the claim(s). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

(a) The examiner respectfully rejected Claims 1, 2, 4-5, 9-12, 15, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Hicks.

The examiner cited Hicks as disclosing a sensor for detecting the presence of a subject and a housing containing the sensor. However, what is disclosed in Hicks is not a sensor but a mechanical lever sensitive to the weight of a bird. As such, Hicks fails to disclose every element of Claims 1 and 18 as required, thus Claims 1 and 18 are considered allowable. And, because Claims 2, 4-5, 9-12 and 15 depend from Claim 1, Claims 2, 4-5, 9-12 and 15 are also considered

allowable.

In regard to Claims 9 and 10, specifically, the invention as disclosed by Hicks includes a perch that is detachable. However, the perch is used to activate the prerecorded message once a bird activates the playback via the weight sensitive perch. If the perch is removed (because it is detachable), it fails to operate and anticipate the present invention as claimed. As such, Claims 9 and 10 are further considered allowable.

(b) The examiner respectfully rejected Claims 1, 4-6 and 18 under 35 U.S.C. § 102(b) as being anticipated by Yu.

The Yu reference discloses a lighting fixture with *motion* detector and announcement device, wherein a person or object entering into a monitored area triggers the announcement device to deliver a prerecorded message.

In contrast, the present invention claims a *presence* detector and initiation of playback of the prerecorded message based on the *presence* of an object. Motion is distinct from presence, as the mere presence of an object in an area would not necessarily trigger the motion detector. Conversely, mere motion would not trigger the presence detector. Therefore, a distinct difference exists between the motion detector claimed in Yu and the presence detector in Claim 1 of the present invention.

Because Yu fails to disclose every element of Claim 1, and dependent Claims 4-6, and Claim 18, the Examiner's rejection of Claims 1, 4-6 and 18 is inappropriate. Claims 1, 4-6 and 18 are presently considered allowable.

**Rejections Under 35 U.S.C. § 103(a)**

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j).

(a) The examiner respectfully rejected Claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Hicks.

Claims 6-8 disclose different presence detecting sensors, one having a light sensing device, one having a laser and laser detection sensor and a heat sensing device, respectively. The examiner has admitted that Hicks fails to specifically disclose these different presence detectors, yet still rejects Claims 6-8 as unpatentable based on obviousness to one of ordinary skill in the art. The applicant feels that the examiner has failed to meet the evidentiary burden required by providing evidence that the claimed elements and/or features are disclosed, taught, suggested and/or claimed by the prior art cited. Failure to meet this burden is indicative of the patentability of the claims in question, and as such, Claims 6-8 are considered allowable.

(b) The examiner respectfully rejected Claims 13-14 under 35 U.S.C. § 103(a) as being unpatentable over Hicks in view of Whitaker.

Whitaker is cited in combination with Hicks as disclosing every element of Claims 13 and 14. However, Whitaker discloses clips and hook and loop material for attaching the device to a bird cage. The present invention discloses brackets, which are different in mechanics and function to more securely hold a device in place (in comparison to clips and/or hook-loop

material). As such, every element of Claims 13 and 14 are not disclosed, taught, suggested or claimed by the combination of Hicks and Whitaker, therefore Claims 13 and 14 are considered allowable.

(c) The examiner respectfully rejected Claims 16 under 35 U.S.C. § 103(a) as being unpatentable over Hicks in view of Manico et al.

The combination of Hicks and Manico et al. appears to render the combination inoperable, since the trough from Manico et al. would be inserted between the weight sensitive ✓perch of Hicks. Either the perch would have to fixed or the trough would be subject to the up and down movement of the perch, and thus subject to spillage of its contents and potential damage. As such, the combination appears to teach away from one another, and would appear to teach away from the present invention. As such, every element of Claim 16 is not disclosed, taught, suggested or claimed by the combination of Hicks and Manico et al., thus Claim 16 is considered allowable.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217

USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a vocal training apparatus having a presence detector and a playback system based on the actuation of the presence detector. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,



Olen L. York, III, Esq.  
Registration No. 53,814

The Law Offices of John D. Gugliotta  
202 Delaware Building  
137 South Main Street  
Akron, OH 44308  
(330) 253-5678  
Facsimile (330) 253-6658